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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,819	06/25/2001	Robin S. Gray		9738

7590 06/18/2003  
ROBIN S. GRAY  
3538 SPLIT RAIL LANE  
ELLCOTT CITY, MD 21042

EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/888,819

Applicant(s)

GRAY, ROBIN S.

Examiner

Ming-Hun Liu

Art Unit

2697

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Mouse point device with integrated touch pad buttons.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6 and 12 are rejected under 35 U.S.C. 102(b) as being unpatentable by US patent 5,805,144 to Scholder.

In reference to claim 6, Scholder shows in figure 2 a portable computer mouse system comprising at least one mouse button (223) and having at least one touch pad (220).

In reference to claim 12, as seen from figure 1, the external computer mouse comprises a housing that is separate from a central processing using housing and separate from a keyboard housing.

4. Claims 13, 18 and 19 are rejected under 35 U.S.C. 102(b) as being unpatentable by US patent 6,107,990 to Fleming.

In reference to claim 13, it can be seen from figure 2 of Fleming that it is apparent that the external computer keyboard mouse system comprises an external computer keyboard, at least one mouse button (210) and at least one touch pad (134).

In reference to claims 18 and 19, it is also apparent from figure 2 of Fleming that at least one touch pad and mouse button is integrated into an opening formed in a sidewall of the keyboard

***Claim Rejections - 35 USC § 103***

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Scholder et al and US patent 5,741,217 to Gero.

In reference to claim 1, Scholder shows in figure 2 a portable computer mouse system comprising at least one mouse button (220) and having at least one touch pad (220), at least one touch pad having a periphery where at least one touch pad is integrated into an opening formed in at least one mouse button, such that the periphery of the touch pad is surrounded by walls of the opening. Scholder has combined the two entities, mouse button and touch pad together. On column 4, lines 62-64, Scholder explains that: "Those of ordinary skill in the art will see, however, that such mechanism surfaces may be placed on various other surfaces of the mouse body in an advantageous manner." Scholder's invention substitutes the prior art buttons, however if one would like to retain the mechanical touch of prior art buttons, one of ordinary skill in the art would have been motivated to place the touch pad on the mouse button, a fitting location as disclosed by Gero and shown in figure 3. It is true that Gero's invention is not

functionally the same as the applicant's claimed invention, however the motivation remains the same. It would have been obvious to one skilled in the art to place a sensor at the mouse button because of its large area and ideal location to receive commands from the user's fingers.

6. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Scholder and Gero as applied to claim 1 above, and further in view of US patent 5,268,674 to Howard et al.

In reference to claims 2-5 the different types of mouse buttons claimed are well known in the art. Howard discloses in his invention (quickly summarized in the abstract) mice with different button types such as: press button, press and lock button, sliding panel and one finger pressing button. It would have been obvious to one skilled in the art to select a particular button type from the numerous conventional mouse button types known in the art.

7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Scholder and Howard. The reasoning of behind this rejection is the same as the rejection outlined for claims 2-5.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable in view of Scholder in view of Howard and further in view of Gero.

Claim 10 is rejected on the grounds outlined in the rejection of claim 1.

In reference to claim 11, Scholder shows in figure 2 a portable computer mouse system comprising at least one mouse button (220) and having at least one touch pad (220). On column

4, lines 62-64, Scholder explains that: "Those of ordinary skill in the art will see, however, that such mechanism surfaces may be placed on various other surfaces of the mouse body in an advantageous manner." Scholder's invention does not account for positioning the touch pad in an opening formed in a sidewall of the external computer mouse system. Gero, as seen in figure 3, does have a sensor on the sidewall of the mouse. One of ordinary skill in the art would have been motivated to place the touch pad on the sidewall of the mouse, because it is a fitting location as disclosed by Gero for a sensor. It is true that Gero's invention is not functionally the same as the applicant's claimed invention, however the motivation remains the same. It would have been obvious to one skilled in the art to place a sensor at sidewall of the mouse because of its large area and ideal location to receive commands from the user's fingers.

9. Claims 14-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fleming and Howard. The reasoning of behind this rejection is the same as the rejection outlined for claims 2-5.

10. Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable in view of Fleming in view Scholder and further in view of Gero.

Claim 17 is rejected on the grounds outlined in the rejection of claim 1.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


US patent 6,507,338 to Laio et al. A integrated touch pad and mouse button.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on 703-305-3885. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Ming-Hun Liu  
June 12, 2003



JOSEPH MANCUSO  
SUPERVISOR